

Appln. No. 10/006,868  
Amendment dated September 3, 2003  
Reply to Office Action mailed June 5, 2003

REMARKS

Reconsideration is respectfully requested.

Claims 1, 3-7 remain in this application. Claim 2 has been cancelled.

The Examiner's rejections will be considered in the order of their occurrence in the Office Action.

Paragraph 1 of the Office Action

The abstract has been objected to. However the office action has provided no information regarding the basis for this objection. The abstract appears to conform to the guidelines put forth in MPEP §608.01(b)

Withdrawal of the objection is respectfully requested.

Paragraph 2 of the Office Action

The specification has been objected to for the informalities noted in the Office Action.

The specification has been amended in a manner believed to clarify any informalities in the language, particularly at the points identified in the Office Action.

Withdrawal of the objection is respectfully requested.

Paragraphs 3 and 4 of the Office Action

Claim 7 has been rejected under 35 U.S.C. §112 (second paragraph) as being indefinite.

The above amendments to the claims are believed to clarify the requirements of the rejected claims, especially the particular points identified in the Office Action.

Withdrawal of the §112 rejection of claim 7 is therefore respectfully requested.

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Paragraphs 5 and 6 of the Office Action

Claims 1 and 3 have been rejected under 35 U.S.C. §102(b) as being anticipated by Mattson.

Claim 1, particularly as amended, incorporates the as filed limitations of claim 2, and as discussed more fully below is believed to be allowable, especially as amended.

Claim 3 is dependent on claim 1, which is believed to be allowable. By virtue of dependence on claim 1, claim 3 is also believed to be allowable.

Withdrawal of the §102(b) rejection of claims 1 and 3 is therefore respectfully requested.

Paragraphs 7 and 8 of the Office Action

Claim 2 has been rejected under 35 U.S.C. Section 103(a) as being unpatentable over Mattson in view of Logson.

Claim 1, particularly as amended, incorporates the as filed limitations of claim 2.

The office action states in part that "It would have been obvious to one of ordinary skill in the art at the time the invention was made to provide the device of Mattson with a female coupled comprising a threaded bore extending into the second end of an elongated body and a male coupled comprising a threaded rod as taught by Logson for efficient tool attachment." However, the Mattson reference teaches away from this combination. It should be noted that Mattson delivers its force towards the material being worked (pushing), while Logson delivers its force away from the material being worked (pulling). Examples of the teaching of Mattson include:

"The end portion of the stem is exteriorly threaded for the reception of an internally annular threaded sleeve 5 and said sleeve terminated, at its lower end, with an inturned flange 5' which flange abuts the end of the stem. Thus it will be noted, a chisel for the tool is developed which will effectively reinforce the socket against

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**hammer blows and prevent springing or bulging of the parts."**  
Column 1 line 50 through column 2 line 3. emphasis added.

"Furthermore, the thumb screw, in addition to holding the tool in the proper position will also **confine the sleeve**, with reference to the stem, whereby jarring of the parts will prevent loosening of the screw threaded connection between said stem and anvil sleeve, it being **understood that the shock of the blows upon the tool will be absorbed by the shoulder 4'** of the same engaging the sleeve flange 5', and also the shoulder connection 2 between the end of the shank and stem." Column 2 lines 16-26. emphasis added.

The law regarding obviousness is clear--any modification of the prior art must be suggested or motivated by the prior art:

'Obviousness cannot be established by combining the teachings of the prior art to produce the claimed invention, absent some teaching or suggestion supporting the combination. Under section 103, teachings of references can be combined only if there is some suggestion or incentive to do so.' [citation omitted] Although couched in terms of combined teachings found in the prior art, the same inquiry must be carried out in the context of a purported obvious "modification" of the prior art. The mere fact that the prior art may be modified in the manner suggested by the Examiner does not make the modification obvious unless the prior art suggested the desirability of the modification.

In re Fritch, 972 F.2d 1260; 23 USPQ2d 1780, 1783-84 (Fed. Cir. 1992), (in part quoting from ACS Hospital Systems, Inc. v. Montefiore Hospital, 732 F.2d 1572, 1577; 221 USPQ 929, 933 (Fed. Cir. 1984)).

In the present case, in light of the Mattson reference teaching away from the combination, the prior art itself cannot provide the necessary motivation for the purposed modification. Therefore withdrawal of the §103(a) rejection of claim 2 is therefore respectfully requested.

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Paragraph 9 of the Office Action

Claims 4-6 have been rejected under 35 U.S.C. Section 103(a) as being unpatentable over Mattson in view of Peterson.

Claims 4-6 are dependent on claim 1, which is believed to be allowable. By virtue of dependence on claim 1, claims 4-6 are also believed to be allowable.

Claim 6, as originally filed, requires a plurality of finger receiving indentations. The office action has purposed a combination with the knurled surfaces of Peterson.

It is submitted that combining elements from different prior art references (in an attempt to establish obviousness) must be motivated or suggested by the prior art.

'Obviousness cannot be established by combining the teachings of the prior art to produce the claimed invention, absent some teaching or suggestion supporting the combination. Under section 103, teachings of references can be combined only if there is some suggestion or incentive to do so.' [citation omitted] Although couched in terms of combined teachings found in the prior art, the same inquiry must be carried out in the context of a purported obvious "modification" of the prior art. The mere fact that the prior art may be modified in the manner suggested by the Examiner does not make the modification obvious unless the prior art suggested the desirability of the modification.

In re Fritch, 972 F.2d 1260; 23 USPQ2d 1780, 1783-84 (Fed. Cir. 1992), (in part quoting from ACS Hospital Systems, Inc. v. Montefiore Hospital, 732 F.2d 1572, 1577; 221 USPQ 929, 933 (Fed. Cir. 1984)).

It is submitted that the combination of Mattson with Peterson is not suggested by the prior art, and even if such a combination were to be made, one would not be led to the combination of features recited in applicants' claims. In particular, the references do not disclose, teach or suggest the use of finger receiving indentations.

It is also submitted that the mere fact that one may argue that the prior art is capable of being modified to achieve a claimed structure does not by itself make the claimed structure obvious--there must be a motivation

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provided by the prior art, and that motivation is totally lacking in the reference.

The examiner finds the claimed shape would have been obvious urging that (our emphasis) "it is obvious for one skilled in the art to form each hook base of any desired shape \*\*\* since *this is within the capabilities of such a person.*" Thus, the examiner equates that which is within the capabilities of one skilled in the art with obviousness. Such is not the law. There is nothing in the statutes or the case law which makes "that which is within the capabilities of one skilled in the art" synonymous with obviousness.

The examiner provides no reason why, absent the instant disclosure, one of ordinary skill in the art would be motivated to change the shape of the coil hooks of Hancock or the German patent and we can conceive of no reason.

Ex parte Gerlach and Woerner, 212 USPQ 471 (PTO Bd. App. 1980) (emphasis in original).

Withdrawal of the §103(a) rejection of claims 4-6 is therefore respectfully requested.

Paragraph 10 of the Office Action

Claim 7 has been rejected under 35 U.S.C. Section 103(a) as being unpatentable over Mattson in view of Logson and Peterson and further in view of Gutierrez and Hull et al.

It is submitted that the need to combine a multiplicity of references in an attempt to meet the claimed invention is evidence of nonobviousness.

In this particular instance five references are combined. As discussed more fully above, the references must suggest the proposed combination in order to establish obviousness. Not only do none of the references suggest combination with any other single reference, there is absolutely no suggestion by any reference that as many as four other references should be

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combined with the potential primary reference. It is therefore further submitted that the examiner has improperly used the applicant's claim 7 as a roadmap to select elements from various references.

In the instant application, the examiner has done little more than cite references to show that one or more elements or subcombinations thereof, when each is viewed in a vacuum, is known. The claimed invention, however, is clearly directed to a combination of elements. That is to say, appellant does not claim that he has invented one or more new elements but has presented claims to a new combination of elements. To support the conclusion that the claimed combination is directed to obvious subject matter, either the references must expressly or impliedly suggest the claimed combination or the examiner must present a convincing line of reasoning as to why the artisan would have found the claimed invention to have been obvious in light of the teachings of the references. . . . Based upon the record before us, we are convinced that the artisan would not have found it obvious to selectively pick and choose elements or concepts from the various references so as to arrive at the claimed invention without using the claims as a guide. It is to be noted that simplicity and hindsight are not proper criteria for resolving the issue of obviousness.

*Ex parte Clapp*, 227 USPQ 972, 973 (B.P.A.I. 1985)

Further, the resulting combination presented in the office action still fails to teach, suggest, or disclose the finger receiving indentations taught in the instant application.

Withdrawal of the §103(a) rejection of claim 7 is therefore respectfully requested.

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**CONCLUSION**

In light of the foregoing amendments and remarks, early reconsideration and allowance of this application are most courteously solicited.

Respectfully submitted,

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Date: 9/5/03

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